



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,312	12/12/2005	Ken Sakamura	263133US90XPCT	3891
22850 7590 04/02/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER HESS, DANIEL A	
			ART UNIT	PAPER NUMBER
			2876	
SHORTENED STATUTORY PERIOD OF RESPONSE		NOTIFICATION DATE	DELIVERY MODE	
3 MONTHS		04/02/2007	ELECTRONIC	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 04/02/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary	Application No. 10/516,312	Applicant(s) SAKAMURA ET AL.	
	Examiner Daniel A. Hess	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/04, 6/06, 9/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is responsive to Applicant's filing of 12/12/2005, which has been entered into the electronic file of record.

Claim Rejections - 35 USC § 112

Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 2 and 6, the language 'large amount', 'high speed' and 'large capacity' are all relative terms and do not have an absolute basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6 rejected under 35 U.S.C. 102(e) as being anticipated by Tominaga et al. (JP H14-109427). **It is noted that this reference is of record in the Applicant's information disclosure statement (IDS).**

Re claim 1: In Tominaga et al., a cellular telephone interacts with a non-contact type ic card to perform an electronic value operation. As for the limitation of 'a memory for storing a large amount of electronic values' it is noted that while the definition of 'large' is somewhat indefinite as discussed above, a cellular phone will certainly have more memory than the smart card with which it interacts.

It is further noted that the language 'for storing a large amount of electronic values' is intended use language in this apparatus claim. The important question in such a case is whether the memory is capable of storing a large amount of electronic values. In the case of Tominaga et al., a cell phone is certainly capable of storing a large amount of electronic values.

Re claim 2: As stated above, the phrases 'high speed' and 'large capacity' are somewhat indefinite. Nevertheless, a cellular phone will generally be more powerful and have larger capacity than a smart card.

Re claim 3: A cell phone is an example of a computer.

Re claim 4: A cell phone is a mobile terminal device.

Re claim 5: See discussion re claims 1 and 3, above.

Re claim 6: See discussion re claim 2, above.

Claims 7-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Korean No. 0249783, of record in the Applicant's information disclosure.

Re claim 7: The above prior art teaches (see English abstract and claim translation) an electronic value transferring device in the form of a mobile terminal which wirelessly communicates with a smart card to exchange value information with the smart card, both to apply payment to the card and extract payment from the card.

Clearly, it is possible to send value from one IC card to another, simply by having two units of the type taught in the recited prior art. One unit can extract value from one smart device into one mobile unit, and this mobile unit (i.e. a cell phone) can communicate with another mobile unit. That unit can then put value onto the smart card that it carries.

A cellular phone or other unit clearly has memory that is capable of storing a plurality of electronic values. The reference discusses how the unit exchanges value data with the smart card and sends it over a network.

Re claim 8: In the Korean No. 0249783, discussed above, the value transferring unit is a mobile telephone.

Re claim 9: A mobile phone is one example of a computer, a computer being defined by its capability rather than by its shape and size.

Re claim 10: As the above reference discusses, the mobile unit communicates with the IC card it carries by “using high frequency bands and low frequency bands” – clearly indicating that the IC card is contactless.

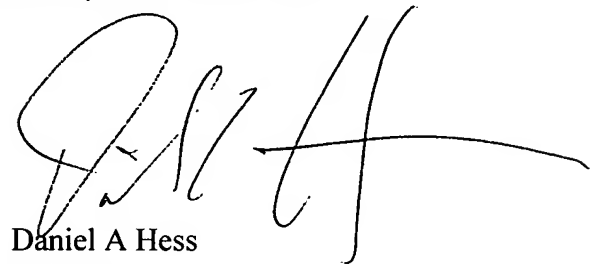
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Smith et al. (US 7,085,931) is made of record in the case.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel A. Hess whose telephone number is (571) 272-2392. The examiner can normally be reached on 8:00 AM - 5:00 PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'D. Hess', with a long horizontal stroke extending to the right.

Daniel A Hess
Examiner
Art Unit 2876

3/26/2007